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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,596	08/31/2001	Nobuko Yamamoto	35.C15718	7458

5514 7590 01/08/2004

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EXAMINER

FREDMAN, JEFFREY NORMAN

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 01/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/942,596

Applicant(s)

YAMAMOTO ET AL.

Examiner

Jeffrey Fredman

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 25, 2003 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Chee et al (Science (1996) 274:610-614)

Chee teaches a method for identifying an unknown base sequence present in a target single stranded nucleic acid (see abstract) comprising the steps:

(a) preparing a probe array in which single stranded nucleic acid probes are arranged as isolated spots on a substrate, the probes each having a base sequence complementary to one of plural base sequences expected to be the unknown base sequence (see page 610, column 2 to page 611, column 1),

(b) reacting a single stranded nucleic acid, which has a base sequence fully complementary to a base sequence of one of the single stranded nucleic acid probes and is fluorescence labeled with the probe array under conditions that single stranded nucleic acids complementary to each other form a double stranded nucleic acid (see figure 1, panel C, top array and page 613, note 12)

removing the unreacted labeled single stranded nucleic acid (see page 613, note 12 and note 13),

measuring fluorescence intensity of each spot of the probe array to obtain a first template pattern showing a relationship between location of the probes and fluorescence characteristics (see page 614, notes 15, 17 and 21)

(c) performing the same operation as the step (b) for each of the remaining single stranded nucleic acid probes and obtaining template patterns of each probe showing a relationship between location and fluorescent characteristics of the probes (see figure 1, panel C, top array, and pages 613 and 614),

(d) performing the same operation as step (b) using a sample containing the target single-stranded nucleic acid of unknown base sequence to obtain a sample pattern showing relationship between a position and fluorescent characteristic (see figure 1, panel C, bottom array and pages 613 and 614)

(e) comparing the sample pattern obtained in step (d) with n pieces of template patterns obtained in steps (b) and (c), to identify a template pattern showing substantially the same pattern as the sample pattern and identifying the base sequence of the single stranded nucleic acid used from the preparation of the identified template

pattern as the unknown base sequence of the target single stranded nucleic acid (see page 611, figure 1 and column 1 and page 612, figure 2 and columns 1-3, where Chee expressly notes "The array was used to successfully detect three disease causing mutations in a mtDNA sample from a patient with Leber's hereditary optical neuropathy. In addition, we detected a total of seven errors and new polymorphisms from previously unsequenced regions (see page 612, column 3).")

(f) Chee further analyzed the probe arrays to calculate a mean value of fluorescent intensities (see page 614, note 18) and then a difference was calculated between the fluorescence intensity of a reference array without a mismatch and the mean value of fluorescent intensities of the double stranded nucleic acids having a one or greater base mismatch (see page 614, note 16 and page 611, column 3) and

(g) Chee expressly notes regarding comparison of one and two mismatches to a control that "The marked decrease in target hybridization intensity, over a span of 20 nucleotides, is shown for a single base polymorphism as position 16,223 (Fig. 2A). The footprint is enlarged when two polymorphisms occur in close proximity (within 20 nucleotides) (Fig. 2B).(see pge 611, column 2)". Chee analyzes each of the positions to show a relationship between location and the fluorescent characteristics of the probes (see page 614, note 16 and page 611, column 3 and figure 2).

(h) Chee compares the sample pattern obtained from the unknown with the known sample pattern to identify the base sequence (see page 612, column 3 and page 614, notes 16 and 18).

Chee determines a two valued pattern using two colors (see figure 2) and has a threshold intensity value (see page 614, note 18, where at least 50 counts above background is required).

Chee teaches probes in the range from 15 nucleotide oligomers (see page 610, column 3).

Chee teaches single base pair mismatch detection (see figure 1).

#### ***Response to Arguments***

4. Applicant's arguments filed October 24, 2003 have been fully considered but they are not persuasive.

Applicant argues that the current method is distinguished from Chee because the current method permits a comparison where the mutations are detected via a difference in the patterns and not by a similarity in the pattern. This argument, with all due respect, does not represent a distinction whatsoever. When Chee, or anyone else, looks at a pattern, such as the pattern of figure 3, in order to compare one pattern with another pattern, two possible alternatives are present. Either the patterns match, or they do not. If they match, they are the same thing, if they do not, they are not. In Figure 3, Chee shows both alternatives. In panel C, the first two mutations do not match, so they are not the same thing. The third mutation does match, so it is the same thing. This showing meets the claim limitations.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Fredman whose telephone number is (571)272-0742. The examiner can normally be reached on 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571)272-0782. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Jeffrey Fredman  
Primary Examiner  
Art Unit 1634